

REMARKS

Claims 11-12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite on the basis that the term "comprising" is asserted to be vague and indefinite. This ground of rejection has been obviated by the amendments to claims 11 and 12 wherein the term "comprising" has been deleted and the term -- consisting of -- has been inserted in its stead.

Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chopdekar et al. (US 5,663,415) in view of Gordziel (US 6,287,597) and Sikora et al. (US 6,268,012). For the sake of brevity, applicants' attorney concedes that such prior art is relevant.

The rejection of claims 1-12 as being unpatentable over the cited prior art has been obviated by incorporation of the limitation of claim 5 into claim 1 and the cancellation of claim 5. Further, claims 6 and 7 have been amended such that they now depend on claim 1 as amended rather than upon claim 5 which has been canceled.

It is respectfully submitted that the incorporation of the limitation of the amount of water being in the range of 0 to about 20 wt.% water in conjunction with the temperature range of about 75 to about 150° renders claim 1 (and dependant claims 2-11) unobvious over the cited prior art. In this connection, the attention of the Examiner is respectfully drawn to the reasons for allowance of two other related patent applications examined by the ~~same~~ Examiner. For the convenience of the Examiner, the following portions of the reasons for allowance have been duplicated below:

S.N. 10/326,349 filed 12/20/2002, allowed 7/23/2004 (patent not yet issued) claims a hot-melt process for preparing carbinoxamine tannate, and the principal cited reference was Chopdekar et al. (US 5,663,415). In his Reasons for Allowance attached to the Notice of Allowability mailed 7/15/2004, Examiner Oh stated on pages 3-4 that:

-- The instant invention, however, differs from the prior art in that none of the prior art have suggested that the reaction takes place on a hot melt basis under a neat condition which describes that no additional diluent or water, such as water is employed during the process; the specific claimed reaction between the carbinoxamine free base and the tannic acid is carried out at a temperature of 50 to 150°C in the presence of 5 to 30 wt.% water; the claimed drying process is conducted by sparging with nitrogen for a period of 1 to 10 hours or more under vacuum and the claimed particle size is specified.

Furthermore, there is no motivation in the prior art to modify the temperature and water concentration in the claims. In addition, unless all limitations of the claim are met, there is no prior art rejection. See In re Zurko, 59 USPO 2d 1690 (Fed. Cir. 1991) and In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 1991).

Therefore, the claimed invention would not have been obvious to the person with an ordinary skill in the art. - -


In a similar vein, S.N. 10/326,361 filed December 20, 2002 (now US Patent 6,833,360 issued December 21, 2004) claimed a process for preparing pseudoephedrine tannate by reacting pseudoephedrine free base with tannic acid neat or in the additional presence of up to about 30 wt.% water at a temperature of about 80 to about 115°C, and thereafter recovering the resultant pseudoephedrine tannate. In this patent application which was also examined by Examiner Oh, the principal cited reference was again Chopdekar et al. (US 5,663,415). In page 3 of the Reasons for Allowance attached to the Notice of Allowability mailed 4/15/2004, Examiner Oh stated:

- - The instant invention, however, differs from the prior art reference in that the recovered pseudoephedrine tannate is milled to provide the free-flowing powder having the specific particle size; the claimed reaction is carried out at a temperature from 80 to 115°C in the presence of little water or 30 wt.% water. Further, there is no motivation in the prior art to modify the temperature and the concentration of water in the prior art to the claimed temperature range and water concentration at the same time. In addition, unless all limitations of the claim are met, there is no prior art rejection. See In re Zurko, 59 USPO 2d 1690 (Fed. Cir. 1991) and In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 1991).- -

Applicants' attorney respectfully submits that the rationale applied by Examiner Oh in allowing related patent applications S.N. 10/326,349 filed 12/20/2002 and S.N. 10/326,361 filed December 20, 2002 fully applies to claim 1 as amended and claims 2-12 dependent thereon. Accordingly, it is respectfully requested that the Examiner re-examine the claims as amended and pass this application to issue in light of the amendments and remarks set forth above.

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Respectfully submitted,


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